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PATENT APPLICATION

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Stephen A. Slesher, Reg. No. 43,824

November 10, 2000
(Date)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Waltherus J.W. Van Venrooij

Serial No. 09/308,150

Filed: September 30, 1999

For: PEPTIDE DERIVED FROM AN ANTIGEN :
RECOGNIZED BY AUTOANTIBODIES FROM :
PATIENTS WITH RHEUMATOID ARTHRITIS, :
ANTIBODY DIRECTED AGAINST SAID :
PEPTIDE, A COMBINATORIAL ANTIGEN, :
AND A METHOD OF DETECTING AUTO- :
IMMUNE ANTIBODIES :

Examiner: A. DeCloux

Group Art Unit: 1644

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PROVISIONAL ELECTION WITH TRAVERSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated October 10, 2000, the Applicants provisionally elect the claims of Invention II, claims 1-3 and 5-7, as amended, drawn to a cyclic peptide, and respectfully traverses the restriction requirement and request that it be reconsidered. The Examiner has further required that the Applicants elect a specific peptide; the Applicants elect the cyclic peptide of SEQ ID NO 10, as is specified in claim 6, as amended.

The Examiner asserts the existence of five inventions: Invention I, with claims 1-4 and 7-9, drawn to a peptide, where said peptide is not cyclic; Invention II, with claims 1-3 and 5-7, drawn to a cyclic peptide; Invention III, claims 10-13, drawn to an antibody; Invention IV, claim 14, drawn to an

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organic compound; and Invention V, claim 15, drawn to a method for the detection of autoantibodies. Applicants provisionally elect the claims of Invention I and the species disclosed in SEQ ID NO 10. Claims 1-3 and 5-7 read on the elected species.

In paragraph numbered 1, the Examiner acknowledges that this Application is filed pursuant to 35 U.S.C. § 371. However, the Examiner holds that the invention lacks unity of invention because the first claim does not provide a technical feature that is distinguished over the prior art, as evidenced by Schellekens et al. (*Arthritis and Rheumatism*, Vol. 40, No. 9, Supplement page 276, November 8 - 12, 1997). Applicants respectfully traverse this ground for holding lack of unity of invention. First, the earliest claimed priority date of the Application is November 15, 1998, the date of filing of Netherlands application 1004539 (see, e.g., International Publication Number WO 98/22503). Thus the Schellekens et al. publication is subsequent to the earliest claimed priority date. Second, certain of the Applicants are among the authors of the Schellekens et al. reference (Schellekens and Van Venrooij), and Applicants are prepared to submit a declaration to the effect that the reference is a publication of Applicants' own invention, and is thus not prior art as to the Applicants. → US

Applicants submit that under U.S.C. § 372 and PCT Rules 13.1 and 13.2, there is a clear and defined "technical relationship among those inventions involving one or more of the same or corresponding special features." Specifically with respect to Inventions I and II, both are subsumed in claim 1, and both are drawn to peptides with specific and defined characteristics. Whether Inventions I and II may be in separate classes under United States rules is not determinative for purposes of PCT Rule 13.2. See, e.g., Annex B, Part 2, to the PCT Administrative Instructions, and specifically Example 17, noting that unity of invention is present between protein X and DNA sequence encoding protein X. Under non-PCT practice, restriction might be appropriate as between protein X and the DNA sequence encoding protein X. However, under the unity of invention standard of PCT Rules 13.1 and

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13.2, unity is present. The current situation is analogous. Whether the peptide is linear or cyclic, it nonetheless has "the same or corresponding special features" and accordingly unity of invention is present. The test is one of whether there "is no single general inventive concept." See, e.g., MPEP 1893.03(d). As noted in MPEP 1893.03(d), the "expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art." Obviously, both linear and cyclic peptides are known in the prior art. Accordingly, the "contribution" is related to the specific and defined characteristics of the peptides as set forth in claim 1.

Applicants respectfully request that the restriction requirement be reconsidered and withdrawn, and that all the claims of the Application proceed to an examination upon the merits.

Should the Examiner have any comments, questions or suggestions relating to a speedy disposition of the Application, he is invited to call the undersigned at (505) 998-6130.

Respectfully submitted,

Date: November 10, 2000

By



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